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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/560,836 | 04/28/2000 | James Grossman | 204,307 | 4613 |
| 24964 | 7590 | 07/01/2005 | EXAMINER | |
| GOODWIN PROCTER L.L.P 103 EISENHOWER PARKWAY ROSELAND, NJ 07068 | | | LE, KHANH H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,836

Applicant(s)

GROSSMAN, JAMES

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is responsive to the Amendment and Response dated 3/28/05. Claims 1-48 have been canceled. New claims 49-73 have been entered. Claims 49, 55, 61, 67 are independent.

Claim Rejections - 35 USC § 112

2. Previous rejections withdrawn as moot.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 49-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clevestine, US 6053536 A in view of Sparks et al. , US 6167382 A and further in view of Goldhaber, US 5855008 A.**

As to claims 49-50, 53, 55-56, 59, 61-62, 65, 67-68, 71, 73

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Clevenstine discloses subsidized mass mailers (see at least col. 3 lines 29-55) distributed to plural users, wherein the users include their own content onto the mass-mailer papers pre-printed with advertisement on the margins (see at least Figs. 3-4 and associated text).

Clevenstine does not teach assembling the mailers using an on-line system. However Sparks discloses customized assembly of the mail piece via Internet at a website with layout template control (abstract, Fig. 1-13 and associated text);

Sparks discloses: establishing an Internet website for receiving/storing user identifying information, forming a database of registered users; electronically transmitting to registered users information that is formatted for printing at a user terminal (abstract, Fig. 1-13 and associated text).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the Sparks Internet document assembly into the Clevenstine method of assembling content onto sheets of marginally pre-printed ads to take advantage of the efficient Sparks' Internet document assembly method to do the ad targeting as taught by Clevenstine at col. 4 lines 1-17.

Clevenstine discloses a template of ads selected based on the user criteria (see at least col. 3 lines 12-20; col. 4 lines 1-7) while Sparks discloses selection of a template by the registered user to make the final print product. It would have been obvious to use Sparks's on-line technology of selection of a template made of ads to effect the selection of mass-mailer ads template as disclosed by Clevenstine (see at least col. 4 lines 1-7) to take advantage of the on-line document assembly taught by Sparks. Providing electronic files made of ads to effect and deliver the template for final assembly of the mail piece as taught by Clevenstine in view of Sparks is well-within the skills of the ordinary skilled in the art at the time of the invention.

Regarding the credits based on the quantity of pages printed with ads, Official Notice is taken that it is old and well-known in the art to insert ads into a communication channel and give credits to the user. This happens in telephone, or internet (see e.g. Goldhaber) channels. The above systems typically compensate the user based on the amount of exposure to the ads. In the

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printing world this would obviously correspond to the number of pages printed. Note that in the mail channel, the Clevenstine's user implicitly gets the benefit of a subsidy per mailer sheet.

Further, Goldhaber discloses establishing an account for a user at a website to accumulate credits, recorded based on the number of exposures to the ads (see at least abstract). It would have been obvious to one skilled in the art at the time the invention was made to add GOLDHABER's method of giving credits to efficiently effect payment of subsidies as taught by Clevenstine while taking advantage of the e-payment technologies and the customer accounts as taught by Goldhaber.

As to claims 51-52, 57-58, 63-64, 69-70, Official Notice is taken that it is well-known to allow redeeming of credits earned as goods and services for the user convenience. It would have been obvious to one skilled in the art at the time the invention was made to add such feature to CLEVENSTINE/SPARKS/GOLDHABER for the above-noted advantage.

As to claims 54, 60, 66, 72 Clevenstine discloses acquiring demographic data regarding the user and targeting the ads based on that data. Further, the printing of ads and other data are disclosed as discussed above.

Further Goldhaber discloses

acquiring on the website demographic, geographic and other information associated with said user; and providing user targeted advertising data based on such acquired data;

It would have been obvious to one skilled in the art at the time the invention was made to add this GOLDHABER's feature of collecting user data on the web for targeting into the system of CLEVENSTINE/SPARKS to use the efficient online user data gathering technology as taught by GOLDHABER.

5. Claims 49-73 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Clevenstine, US 6053536 A in view of Farros, US 5930810, and further in view of Goldhaber, US 5855008 A.

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As to claims 49-50, 53, 55-56, 59, 61-62,65, 67-68,71, and 73,

Clevenstine discloses subsidized mass mailers (see at least col. 3 lines 29-55) distributed to plural users, wherein the users include their own content onto the mass-mailer papers pre-printed with advertisement on the margins (see at least Figs. 3-4 and associated text).

Clevenstine does not teach assembling the mailers using an on-line system. However Farros discloses: customized assembly of the mail piece via Internet at a website;

a printing system with pre-defined user modifiable forms, local printing (see at least abstract; col. 2 line 20 to col. 4 lines 55)

files of backgrounds of available pre-printed printable media (see at least col. 4 lines 30-36; Figs. 4 and associated text)

Farros implicitly discloses a website for user registration ((see at least Figs. 4 and associated text)

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the Farros Internet document assembly into the Clevenstine method of assembling content onto sheets of marginally pre-printed ads to take advantage of the efficient Farros' Internet document assembly method to do the ad targeting as taught by Clevenstine at col. 4 lines 1-17.

Clevenstine discloses a template of ads selected based on the user criteria (see at least col. 3 lines 12-20; col. 4 lines 1-7) while Farros discloses selection of a template by the registered user to make the final print product. It would have been obvious to use Farros's on-line technology of selection of a template made of ads to effect the selection of mass-mailer ads template as disclosed by Clevenstine (see at least col. 4 lines 1-7) to take advantage of the on-line document assembly taught by Farros. Providing electronic files made of ads to effect and deliver the template for final assembly of the mail piece as taught by Clevenstine in view of Farros is well-within the skills of the ordinary skilled in the art at the time of the invention.

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Regarding the credits based on the quantity of pages printed with ads, Official Notice is taken that it is old and well-known in the art to insert ads into a communication channel and give credits to the user. This happens in telephone, or internet (see e.g. Goldhaber) channels. The above systems typically compensate the user based on the amount of exposure to the ads. In the printing world this would obviously correspond to the number of pages printed. Note that in the mail channel, the Clevenstine's user implicitly gets the benefit of a subsidy per mailer sheet.

Further, Goldhaber discloses establishing an account for a user at a website to accumulate credits recorded based on the number of exposures to the ads (see at least abstract). It would have been obvious to one skilled in the art at the time the invention was made to add GOLDHABER's method of giving credits to efficiently effect payment of subsidies as taught by Clevenstine while taking advantage of the e-payment technologies and the customer accounts as taught by Goldhaber.

As to claims 51-52, 57-58, and 63-64, 69-70, Official Notice is taken that it is well-known to allow redeeming of credits earned as goods and services for the user convenience. It would have been obvious to one skilled in the art at the time the invention was made to add such feature to CLEVENSTINE/FARROS/GOLDHABER for the above-noted advantage.

As to claims 54, 60, 66, 72 Clevenstine discloses acquiring demographic data regarding the user and targeting the ads based on that data. Further, the printing of ads and other data are disclosed as discussed above.

Further Goldhaber discloses

acquiring on the website demographic, geographic and other information associated with said user; and providing user targeted advertising data based on such acquired data;

It would have been obvious to one skilled in the art at the time the invention was made to add this GOLDHABER's feature of collecting user data on the web for targeting into the system of CLEVENSTINE/FARROS to use the efficient online user data gathering technology as taught by GOLDHABER.

Conclusion

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

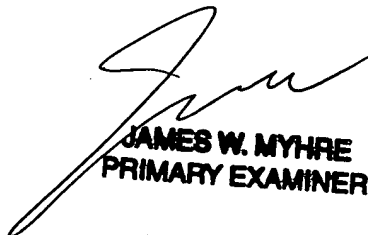
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 24, 2005

KHL
KHL


JAMES W. MYHRE
PRIMARY EXAMINER